

## REMARKS

Claims 1-5, 8-14, 16-29, and 31-41 are pending. Claims 1-5, 8-14, 16-29, and 30-41 are rejected. Claims 6-7, 15 and 30 have been previously canceled.

### Claim Rejections - 35 U.S.C. § 102(e)

The Examiner has rejected claims 1, 4-5, 8-12, 14, 16-18, 20-29 and 31-41 under 35 U.S.C. § 102(e) as anticipated by Makela et al. (U.S. Patent Publication No. 2001/0028709), herein Makela. The Applicants include the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully request a favorable reconsideration of claims 1, 4-5, 8-12, 14, 16-18, 20-29 and 31-41.

These rejections are respectfully disagreed with, and are traversed below.

The Examiner is respectfully reminded that for a rejection to be made under 35 U.S.C. § 102(e), it is well recognized that "to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art", *Ex Parte Gould*, BPAI, 6 USPQ 2d, 1680, 1682 (1987), citing with approval *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978).

Regarding claim 1, which recites:

"A method comprising:  
in a terminal of a first party participating in a telephone call, storing, as a consequence of the telephone call, identifier data that identifies a second party participating in the telephone call;  
using the stored identifier data to determine automatically a destination address for a data message;  
receiving a selection of a delivery mechanism; and  
controlling a transmitter to send, during the telephone call, a data message with the automatically determined destination address, wherein said transmitter is controlled to send said data message out-of-band relative to the telephone call using the selected delivery mechanism" (emphasis added).

The Examiner asserts that Makela teaches:

"in a terminal of a first party ("a mobile communications device" see [0022]) participating in a telephone call ("an incoming call is noticed" see [0022]), storing, as a consequence of the telephone call ("it can be automatically stored" see [0026]), identifier data that identifies a second party participating in the telephone call ("telephone number of the calling party" see

[0026]);

using the stored identifier data to determine automatically a destination address for a data message (“Transmission of a short message can be effected automatically” see [0014] and “program his/her device in advance so that it sends a short message” see [0025]);

receiving a selection of a delivery mechanism (“the reply service employing the short message service (SMS Reply) is switched on” see [0022]); and

controlling a transmitter to send ((“a mobile communications device” see [0022]), during the telephone call (“an incoming call is noticed” see [0022]), a data message with the automatically determined destination address (“in advance, which message is sent to each calling party” see [0025]), wherein said transmitter is controlled to send said data message **out-of-band relative to the telephone call** (“an incoming call is noticed” see [0022]) using the selected delivery mechanism (“the reply service employing the short message service (SMS Reply) is switched on” see [0022])” (emphasis added).

Consider the disclosure of Makela:

“The operation starts from point 1, where an **incoming call is noticed**. The apparatus checks according to point 2 if the reply service employing the short message service (SMS Reply) is switched on. If not, it moves to point 3 corresponding the treatment of the call in a usual and known way. When the service is switched on, the apparatus then checks in point 4 which kind of an alarm procedure is applied to and in point 5 if the identity code of the caller (CLI, Caller Line Identity) is available. The latter is required for sending a short message... In point 7, the **message is sent** to the calling party, supposing that the communication device of the calling party has the short message function... In point 8 the call can further be **routed to a normal call answering machine** that can be in connection with the same mobile communication device or some exchange apparatus” (paragraph [0022], emphasis added).

“An advantage of using a locally stored voice message as an answer to an incoming call according to the invention is that the caller momentarily reacts as if the receiving party had answered him/herself. That is, the caller does not for example hang up immediately when he/she perceives the answer, as could be the case if an SMS message would be sent as an answer together with an electronic answering tune. We may suppose that the receiving party is attending a lecture, where speaking is not permitted, and he/she **wants the calling party to wait, without hanging up**, until the receiving party has got out of the lecture room and reached the lounge where he/she may speak freely... the receiving party detects the incoming call through a silent alarm of his/her telephone, optionally also sees from the display who is calling, gives a key command that causes the telephone to send a voice message “Please wait for a moment, I'll be back after a short while” and walks quietly out of the room to be able to speak to the phone. This method also works in the middle

of a telephone conversation, if one of the parties must have a short break for some reason" (paragraph [0051], emphasis added).

A first approach in Makela is described where "an incoming call is noticed" and a check is made to see if "the reply service employing the short message service (SMS Reply) is switched on". If not switched on the call is handled "in a usual and known way". If the SMS reply service is in an active state, a user-selected alarm procedure is applied where, if the caller (person making the incoming call) is identified, "the message is sent to the calling party". Finally, the incoming call may be "routed to a normal call answering machine". Makela clearly states, the predetermined SMS message is used to provide the calling party with information when the user is in a situation where the user can't answer the call him/herself, for example, being in a meeting (see Abstract, paragraphs [0026]-[0027]).

In other words, the first approach of Makela discloses a mechanism that may be used to replace or complement a conventional answering machine/service such as voicemail. However, this does not disclose or suggest claim 1.

According to teachings of Makela a caller places a call to a user, who instead of answering the call (as the "user can't answer the call him/herself") provides an SMS message as a response to the caller in order to provide information regarding his/her unavailability. As the user does not "answer the call", the terminal is not "participating in a telephone call" with the caller. Thus, the SMS message is not provided "during the telephone call" with the caller. Rather, the noticed incoming call is routed to an answering machine/service instead of being answered.

The predetermined SMS message in Makela is used to provide information regarding the reason for **not answering** the call and/or regarding the availability of the called party and thereby acts as an alternative (or a replacement) for a traditional answering machine/service. Thus, the teachings of Makela are contradictory to "controlling a transmitter to send, during the telephone call, a data message" to the other party of the call.

Makela also discloses another approach where a voice message is read from the memory and sent to the calling party, for example, "to send a voice message "Please wait for a moment, I'll be back after a short while"" (see paragraph [0051]).

Assuming, arguendo, that the “voice message” is analogous to “a data message” (which the Applicants do not so assert), Makela does not disclose or suggest that the voice message is sent “out-of-band”. Rather, Makela appears to teach that the voice message would be sent to the calling party within the call when answering (as the caller “wants the calling party **to wait, without hanging up**”). Consequently, Makela does not teach the message is sent “out-of-band relative to the telephone call”.

Clearly, Makela does not disclose (or suggest) “to send said data message” to “a second party participating in the telephone call”, the message being sent “out-of-band relative to the telephone call” as in claim 1.

As Makela does not disclose or suggest all elements of claim 1, Makela does not anticipate claim 1. For at least this reason, claim 1 is in condition for allowance.

As claims 12, 20, 28, 33-34 and 39-40 recite similar language to that discussed above with reference to claim 1; claims 12, 20, 28, 33-34 and 39-40 are likewise in condition for allowance. Claims 4-5, 8-11, 14, 16-18, 21-27, 29 and 31-41 depend upon claims 1, 12, 20 and 28. For at least this reason, they are likewise in condition for allowance.

Regarding claim 5, the Examiner asserts that Makela discloses “wherein the telephone call is a circuit switched telephone call (“an incoming call is noticed” see [0022])”. It is unclear how Makela is interpreted to disclose that the “incoming call is specifically “a circuit switched telephone call”. It is noted that a word search of Makela does not reveal an instances of the terms “circuit switched telephone call”, “circuit switched” and/or “circuit”.

Regarding claim 20, the Examiner asserts Makela discloses “controlling a display to provide (window of the SMS Reply Mode will be displayed in the display” see [0029], while the telephone call is on-going (fig. 1, step 1), a user selectable option...”. However, it is unclear from the description where Makela is suggested as teaching to display the “window of the SMS Reply Mode” “while the telephone call is on-going”. Rather, Makela discloses checking “if the reply service employing the short message service (SMS Reply) is switched

on" when "an incoming call is noticed". Thus, it appears that the SMS Reply "is switched on" prior to the "incoming call" ("The user can e.g. program his/her device in advance so that it sends a short message only in reply" paragraph [0025]). Clearly, Makela does not disclose or suggest "controlling a display to provide, while the telephone call is on-going, a user selectable option" as in claim 20.

The Examiner is respectfully requested to reconsider and remove the rejection under 35 U.S.C. § 102(e) based on Makela, and to allow claims 1, 4-5, 8-12, 14, 16-18, 20-29 and 31-41.

#### **Claim Rejection - 35 U.S.C. § 103(a)**

The Examiner has rejected claim 19 as being unpatentable under 35 U.S.C. § 103(a) over Makela in view of Stanford et al. (U.S. Patent No. 6,980,641), herein Stanford; and claims 2-3 and 13 as being unpatentable under 35 U.S.C. § 103(a) over Makela in view of Alperovich (U.S. Patent No. 5,819,180), herein Alperovich. The Applicants include the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully request a favorable reconsideration of claims 2-3, 13 and 19.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a *prima facie* case for obviousness. Thus, as interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*, the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made.<sup>1</sup>

As seen above, Makela does not disclose or suggest claims 1 and 12. As claims 1 and 12

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<sup>1</sup> *In Re Fine*, 5 U.S.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Agmen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); *In Re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

are allowable over Makela then all claims that depend from claims 1 and 12 should also be allowable over Makela, whether considered alone or in combination with other art cited as applied by the Examiner. Further, the addition of the disclosures of Stanford and/or Alperovich to Makela (without admitting that such combinations are suggested or technically feasible), would not cure the deficiencies in the disclosure of Makela. For at least this reason, claims 2-3, 13 and 19 are in condition for allowance.

In light of the discussion above, the Applicants respectfully assert that a prima facie case for obviousness was not presented as required by the court in *In re Lee*. As such, the Applicants respectfully request that the Examiner reconsider and withdraw these rejections to claims 2-3, 13 and 19.

For the foregoing reasons, the Applicants believe that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

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2/16/11

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